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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,687	10/23/2003	Suzanne Gibson	2435U.001	6631
21917	7590	01/18/2008		
MCHALE & SLAVIN, P.A. 2855 PGA BLVD PALM BEACH GARDENS, FL 33410			EXAMINER DURHAM, NATHAN E	
			ART UNIT 3765	PAPER NUMBER
			MAIL DATE 01/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/691,687

Applicant(s)

GIBSON, SUZANNE

Examiner

Nathan E. Durham

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment and Arguments

Applicant's amendment and arguments, filed 6 November 2007, have been
5 reviewed and considered. Claims 27-29 have been amended, claim 34 has been added
and claims 1-26 have previously been cancelled. Therefore, claims 27-34 are currently
pending. Applicant's arguments corresponding to the amendment have been
considered but are moot in view of the new ground(s) of rejection.

In response to the applicant's argument regarding the material of the printable
10 laminate, the examiner points the applicant to line 66 of column 3. RIFKIN discloses the
laminate being "paper". Paper is known in the textile art as a type of fabric wherein a
fabric is considered a cloth. In further regards, in the last paragraph of page 11
(applicant's specification), the applicant recites "While the peel-off covers 23 are
preferably constructed from a cloth type material other materials well known in the art
15 suitable for passing through a printer may be utilized including, but not limited to,
papers, textured papers, embossed papers or suitable combinations of paper and
cloth".

In response to the applicant's argument regarding RIFKIN failing to disclose a
scanner, a color copier or a digital camera being a peripheral device, refer to the
20 Background section of RIFKIN. The invention of RIFKIN doesn't directly state how the
image designs are imported; however, RIFKIN discloses the use of peripheral devices
such as a color scanner (Col. 2, Lines 6-11) (also considered a copier) and a digital

camera (Col. 1, Lines 60-65) being commonly known in the art for importing image designs into digital images to be further used in a design and printing process.

Accordingly, it is obvious to include the disclosed peripheral devices, as disclosed in the Background, in the method of RIFKIN. In further argument, the applicant's disclosure

5 expresses the use of peripherals such as sketch pads, digitizers, scanners, digital video cameras and still cameras as being well known in the art to create computer images

(Applicant's Specification; Page 2, Lines 6-13) (Page 12, Lines 21-23). In response to

the applicant's argument corresponding to the rejection of claim 32, note the use of a

network as a peripheral device as described in Column 13, lines 33-39 of U.S. Patent

10 6,324,441. Also note the use of a network as the Internet in U.S. Patent 6,196,146. In

further regards, it is old and known that images can be saved from a web page and

used for later purposes by the user involved with editing (i.e. Photoshop, Microsoft

Paint) and printing procedures (Inkjet printer).

Regarding the applicant's amended claim language involving selecting an entire

15 surface and covering the entire surface with the peelable blank, note sticker 77 on the

upper surface of structure 75 of RIFKIN. This Office Action is considered a Final

Rejection.

Claim Rejections - 35 USC § 112

20 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Within paragraphs 2-4 of claims 27 and 34, the applicant recites that "said computer program [is] configured to include **the dimensions of** a plurality predetermined shoe models and a plurality of image designs". The applicant further recites that while selecting one of the shoe models for display "**the dimensions of the outer contour perimeter of a form fitting overlay are established**" and while selecting one of the image designs "**establishing a size and position proportional to said outer contour perimeter**". Nowhere in the specification does the applicant mention dimensions of the shoe models or dimensions of the plurality of image designs being included in the computer program. The applicant's specification only discusses the selection of an article of clothing and the selection or creation of a user-created image (Line 21 of page 13 –line 5 of page 14). The applicant's specification further fails to mention a form fitting overlay or an outer contour perimeter of such. Therefore, the above discussed amended claim language is considered new matter that fails to have support within the applicant's specification.

Within paragraphs 5 and 8 of claims 27 and 34, the applicant recites "selecting **the entire surface** from an upper portion of said shoe model **above a sole of said shoe model**" and later having the peelable blank covering "**the entire size and shape**

of said selected surface of said upper portion of said shoe model". Applicant's figure 5 appears to show peelable blanks covering an entire size and shape of a particular surface, however, the figure alone fails to provide the support of the applicant's claim language. Nowhere in the specification does the applicant suggest the method step of

5 selecting an entire surface of a shoe model above a sole of said shoe model. In the last paragraph of page 14 continuing into page 15, the applicant recites "If the user prefers to relocate the user-created design image 42, the user is able to click upon image 42 using mouse 14 and drag design image 42 to a different location upon the article of clothing image 40". How does this described process of selecting a shoe
10 model surface show the selection of an entire surface of the shoe model above a sole of said shoe model?

Claim 34 also contains new matter based on the use of the phrase "consisting of". There is no support in the applicant's specification for such a limited combination of particular method steps considering numerous steps are included in the specification
15 that are not included within claim 34 (For example: the alteration of a user-created image as shown in the second paragraph of page 14).

Claims 28-33 are dependent from claim 27 and are therefore also rejected under 35 U.S.C. 112, first paragraph.

An updated search was performed on the amended claims and no relevant art
20 was found.

Conclusion

The prior art made of record, as cited in attached PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

5 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not
10 mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan E. Durham whose telephone number is (571) 272-8642. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
20 supervisor, Gary L. Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10

NED


GARY L. WELCH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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